

## REMARKS

### Status of Claims

Claims 1-36 are pending in the application and rejected. Claims 1-36 are rejected. Claim 36 has been canceled. Claims 2 and 3 have been amended. New claims 37-44 have been added. Support for the heat-treated tissue volume being rectangular is found in the specification at paragraph [0008]. Support for the width of the heat-treated volume being confined by two to four of the needles is found in FIG. 3. Support for the heat treated tissue volume being centered on the planned incision lines is found in the specification at paragraph [0003]. No new matter has been added. Reconsideration and withdrawal of the rejections set forth in the Office Action mailed January 18, 2008 are respectfully requested.

### Rejection Under 35 U.S.C. §103(a)

Claims 1-6, 12-19 and 25-36 were rejected under 35 U.S.C. §103(a) as being obvious over Edwards et al. (USPN 5,472,441) in view of Edwards (USPN 5,836,906) in still further view of Swanson (USPN 6,267,760) and still in further view of Daniel et al. (USPN 7,008,421). Claims 7-11 and 20-24 were rejected under 35 U.S.C. §103(a) as being obvious over the same references cited above, and further in view of Applicant's admission that the species are not patentably distinct. Preliminarily, Applicant notes that Daniel et al. is not prior art to the present application. Daniel et al. has a priority date of August 21, 2002 while the present application is entitled to a priority date of August 5, 1998.

With regard to claims 1 and 2 the Examiner states that Edwards '441 in view of Edwards '906 in view of Swanson '760 substantially teach the claimed invention and Daniel et al. discloses heating the tissue sufficiently with the needles in order to resect the tissue bloodlessly. Because Daniel et al. is not prior art to the present application Applicant respectfully suggests that the combination of Edwards '441, Edwards '906 and Swanson '760 suggested by the Examiner does not teach, suggest or disclose the claimed invention. Allowance is respectfully requested.

Regarding claim 3, Applicants respectfully submit that none of the cited references, alone or in combination, teach or suggest a method that involves creating a heat-treated tissue volume *centered* on the planned incision line, the width of which is confined by 2 to 4 needles, and making

the incision *centered* along the heat-treated tissue volume. If an independent claim is nonobvious then any claim depending therefrom is nonobvious. MPEP §2143.03. Claims 4-18 depend from an allowable base claims and therefore are also allowable.

Regarding claims 19-35 each of the claims depend from an allowable base claim and are therefore also allowable. MPEP §2143.03.

Applicants respectfully request withdrawal of each of the various rejections under 35 U.S.C. § 103(a).

#### New Claims 37-44

Applicant has added new claims 37 to 44 and suggest that none of the cited references, alone or in combination, teach, disclose or suggest the claimed limitations.

Regarding claim 29, neither Edwards '441, Edwards '906 or Swanson '760 teach or suggest "applying said electromagnetic energy via said needles to said tissue volume to coagulate tissue in a coagulation volume, said coagulation volume containing said planned incision plane, straddling said incision plane and extending to the planned incision depth, in order to convert tissue in said coagulated volume from tissue prone to bleeding upon incision thereinto into tissue resistant to bleeding upon incision thereinto; and making an incision to the planned incision depth along said planned incision plane to effect bloodless resection of tissue from the body" as recited by claim 29. Nothing in the prior art suggests piercing and perforating a tissue which is prone to bleeding as part of a method of controlling excessive bleeding during a resection procedure.

Moreover, none of the cited prior art documents disclose needles in at least two rows, inserting the rows into tissue with the rows straddling the planned incision plane wherein electromagnetic energy is applied three-dimensionally across the planned incision plane.

Applicant respectfully suggests that new claims 37 to 44 are also allowable over the art of record.

#### The Shevchenko Declaration

The Examiner states that the Shevchenko is insufficient to overcome the rejection of claims 1-36 based upon the rejections under 35 U.S.C. §103(a) as being unpatentable over Edwards et al. '441 in view of Edwards '906 further in view of Swanson '760 and further in view of Daniel et al. (the latter not being prior art). The Examiner states that the claims are directed to a method of use and the support offered by the declaration is the estimated market share of a device not the method of use. Applicant respectfully suggest that it has fully complied with the requirements of MPEP §716.03(a) as the evidence of commercial success offered is indeed commensurate in scope with the claims. The Applicant has offered evidence of the relationship between the claimed features, the commercial product and the process of using the product. The apparatus creates the method of use. There is no method of using the product without the product itself. Therefore, evidence of the commercial success of the product is indeed relevant to the process. Applicant respectfully requests reconsideration of the Shevchenko Declaration.

#### The Bismuth Declaration

The Examiner does mention the Bismuth Declaration, filed on November 14, 2007 at all. This Bismuth Declaration addresses the method of using the apparatus and why the method is not obvious over Edwards in view of Edwards in view of Swanson. Daniel is not prior art and need not be considered. Consideration of the Bismuth Declaration is respectfully requested.

#### Conclusion

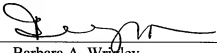
All rejections having been addressed Applicant earnestly solicits a Notice of Allowance in this case. If the Examiner believes that a teleconference would be of value in expediting the allowance of the pending claims, the undersigned can be reached at the telephone number listed below. Applicant hereby petitions for a three-month extension of time, the statutory period for response having expired on April 18, 2008 and this response being filed on or before the three-

month extension period of July 18, 2008. Applicant hereby authorizes the Commissioner to charge the three-month extension of time fee to Deposit Account No. 50-1901 (Reference #22413-14).

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Respectfully submitted,

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